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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,726	10/18/2004	Winfried Juschka	016906-0346	2546
22428	7590	08/29/2005	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			GIMIE, MAHMOUD	
		ART. UNIT	PAPER NUMBER	
		3747		
DATE MAILED: 08/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

TAK

Office Action Summary	Application No.	Applicant(s)	
	10/511,726	JUSCHKA ET AL.	
	Examiner	Art Unit	
	Mahmoud Gimie	3747	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 October 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-16 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 18 October 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/18/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: "AGR" in line 2 should "EGR" to be accurate. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Brigham et al (4,685,292).

Brigham et al discloses an exhaust heat exchanger (20), in particular for motor vehicles having an exhaust gas recirculation system (EGR), composed of a housing jacket (30, 36) for a coolant, and of a nest of pipes (50) through which exhaust gas flows and around which coolant flows and which is held in the housing by pipe plates (32, 34), the nest of pipes (50), the pipe plates (42, 34) and the housing (30, 36) forming an enclosed force flux, characterized in that a sliding fit (figure 6) is arranged in the force flux.

With regard to claim 2, the sliding fit (figure 6) is arranged in the housing jacket (30,36).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 3-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brigham et al (U.S. 4,685,292) in view of Metcalfe (4,171,832).

Brigham et al discloses all the claimed features as shown in the above rejection of claim 1, except for the arrangement of the sliding fit or relaxing joint.

With regard to claim 3, Brigham et al does not show the sliding fit arranged between a pipe plate and the housing jacket.

Metcalfe shows sliding fit (figure 4) arranged between a pipe plate or header (50) and the housing jacket or sleeve (78).

Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Brigham et al by arranging the sliding fit

between the pipe plate and the housing jacket. The motivation to do so would have been to properly position the tubes (56, 50), column 8 and line 3 of Metcalfe.

With regard to claim 4, the housing jacket is divided transversely (figure 3) with respect to the direction of the force flux and has an end region with a relatively large cross section (66) and an end region with a relatively small cross section (62), said regions overlapping in the direction of the force flux and being guided and sealed (70) so as to slide one in the other.

With regard to claim 5, a plastic layer (claim 16) is arranged as a sliding layer between the end regions.

With regard to claim 6, the sealing means are arranged between the end regions

With regard to claims 7-12, see figures 2-9 of Metcalfe.

With regard to claims 13, 14 and 15, arranging drainage between two o-rings would have been within the general knowledge of one skilled in the art.

With regard to claim 16, the drainage embodied as an annular groove in the housing is an optional design choice suitable for a particular intended use.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references show heat exchangers with relaxing joints or equivalent to prevent thermal stresses and/or strains.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mahmoud Gimie whose telephone number is 571-272-4841. The examiner can normally be reached on Tuesday-Friday between 7 a.m. -3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Yuen can be reached on 571-272-4856. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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MAHMOUD GIMIE
PRIMARY EXAMINER